

REMARKS

I. Introduction

Claims 1 to 14 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1 to 5 and 7 to 11 Under 35 U.S.C. § 103(a)

Claims 1 to 5 and 7 to 11 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of International Published Patent Application No. WO 98/53229 ("Werner et al.") and U.S. Patent No. 6,471,212 ("Dierker et al."). Applicants respectfully submit that the combination of Werner et al. and Dierker et al. does not render obvious the present claims for the following reasons.

Applicants respectfully submit that the combination of Werner et al. and Dierker et al. does not render obvious claims 1 and 9 for at least the reason that the combination of Werner et al. and Dierker et al. fails to disclose, or even suggest, all of the limitations recited in claims 1 and 9. For example, the combination of Werner et al. and Dierker et al. fails to disclose, or even suggest, that the first positioning arrangement and the second positioning arrangement are configured to interact with each other in a positive-locking manner and to provide definite positioning of the bristle housing so as to prevent relative rotation and incorrect mounting of the entire bristle housing, as recited in claims 1 and 9. With respect to Werner et al., the Office Action identifies "portion of 4 abutting 2" as a first positioning arrangement and "portion of 2 abutting 4" as a second positioning arrangement. However, the Office Action admits that "Werner fails to disclose the first and second positioning arrangements to be configured to interact with each other in a positive locking manner providing definite positioning of the bristle housing." Office Action at page 2.

The arrangement disclosed by Dierker et al. also does not provide definite positioning of the bristle housing because the arrangement disclosed by Dierker et al. does not prevent incorrect mounting of the bristle housing. The Specification states at page 1, lines 18 to 28, that "[t]he bristles of the brush seals can be set in the direction of rotation of the rotor at an angle of, for example, 40° to 50°, in order to permit a smooth, radial deflection of the bristles upon contact with the rotor [and that on] account of the set bristles, reliable functioning in the event of

incorrect installation of the brush seal, i.e., the brush seal is inserted in the incorrect orientation into its seat on the stator or rotor and the bristles are set against the direction of rotation of the rotor, is not ensured, since the bristles can partly bend to a considerable extent.” The Specification also states at page 1, line 33 to page 2, line 1 that “[i]t is an object of the present invention to provide a brush seal with which correct ... installation is ensured when the brush seal is assembled.” With respect to Dierker et al., the Office Action identifies cutout 12 and shoulder 13 as first and second positioning arrangements, respectively. Office Action at page 2. Dierker et al. describes that “[t]he basic body 7 and the guide plate 8 are seated in a groove 10 of the housing [, the] groove ha[ving] a cutout 12, in which the guide plate 8 is suspended by means of a corresponding shoulder 13.” Column 2, lines 30 to 33. As clearly shown, however, the shoulder 13 and the cutout 12 do not function to prevent incorrect mounting of the bristle housing because the basic body 7 which carries the brushes 6 may be installed in a reversed, incorrect orientation, e.g., with the brushes angled in the wrong direction.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Since the combination of Werner et al. and Dierker et al. does not disclose, or even suggest, all of the limitations of claims 1 and 9 as more fully set forth above, it is respectfully submitted that the combination of Werner et al. and Dierker et al. does not render obvious claims 1 and 9. In view of the foregoing, withdrawal of the rejection of claims 1 and 9 is respectfully requested.

In addition, Applicants respectfully submit that claims 2 to 5, 7, 8, 10 and 11, which ultimately depend from claim 1, and therefore include all of the limitations of claim 1, are also not rendered unpatentable by the combination of Werner et al. and Dierker et al. for at least the same reasons given above in support

of the patentability of claim 1. In re Fine, supra (any dependent claim depending from a non-obvious independent claim is non-obvious).

III. Rejection of Claims 6, 8 and 9 Under 35 U.S.C. § 103(a)

Claims 6, 8 and 9 were rejected under 35 U.S.C. § 103(a) as unpatentable over Werner et al. and Dierker et al., and further in view of U.S. Patent No. 6,106,190 ("Nakamura et al."). Office Action at p. 5. It is respectfully submitted that the combination of Werner et al., Dierker et al. and Nakamura et al. does not render obvious claims 6, 8 and 9 for the following reasons.

Applicants respectfully submit that the combination of Werner et al., Dierker et al. and Nakamura et al. does not render obvious claims 6 and 9 for at least the reason that the combination of Werner et al., Dierker et al. and Nakamura et al. fails to disclose, or even suggest, all of the limitations recited in claims 6 and 9. For example, the combination of Werner et al., Dierker et al. and Nakamura et al. fails to disclose, or even suggest, that the first positioning arrangement and the second positioning arrangement are configured to interact with each other in a positive-locking manner and to provide definite positioning of the bristle housing so as to prevent relative rotation and incorrect mounting of the entire bristle housing, as recited in claims 6 and 9. As more fully set forth above in connection with claim 9, neither Werner et al. nor Dierker et al. disclose or suggest such an arrangement. Furthermore, Nakamura et al. is not relied on to disclose or suggest, and does not disclose or suggest, first and second positioning elements that interact with each other in a positive-locking manner and to provide definite positioning of the bristle housing so as to prevent relative rotation and incorrect mounting of the bristle housing.

Therefore, Applicants respectfully submit that the combination of Werner et al., Dierker et al. and Nakamura et al. does not render obvious claims 6 and 9. Withdrawal of the rejection of these claims is therefore respectfully requested.

In addition, Applicants respectfully submit that claim 8, which depends from claim 1 and therefore includes all of the limitations of claim 1, is also not rendered unpatentable by the combination of Werner et al., Dierker et al. and Nakamura et al. Since claim 8 depends from independent claim 1, and since Nakamura et al. simply do not cure the critical deficiencies of Werner et al. and

Dierker et al., as more fully described above, it is respectfully submitted that claim 8 is allowable for at least the same reasons that claim 1 is allowable. In re Fine, supra.

IV. Rejection of Claims 12 and 13 Under 35 U.S.C. § 103(a)

Claim 12 and 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Werner et al., Dierker et al., and U.S. Patent No. 5,066,024 ("Reisinger et al."). It is respectfully submitted that the combination of Werner et al., Dierker et al. and Reisinger et al. does not render obvious claims 12 and 13 for the following reasons.

As more fully set forth above, the combination of Werner et al. and Dierker et al. does not disclose, or even suggest, all of the limitations of claim 1. Claims 12 and 13 depend from claim 1 and therefore include all of the limitations of claim 1. Reisinger et al. are not relied on to disclose or suggest, and do not disclose or suggest, those features of claim 1 not disclosed or suggested by the combination of Werner et al. and Dierker et al.. For instance, Reisinger et al. are not relied on to disclose or suggest, and do not disclose or suggest, that the first positioning arrangement and the second positioning arrangement are configured to interact with each other in a positive-locking manner and to provide definite positioning of the bristle housing so as to prevent relative rotation and incorrect mounting of the entire bristle housing, which as more fully described above, is not disclosed or suggested by the combination of Werner et al. and Dierker et al. Rather, Reisinger et al. describe "[a] brush seal 1a [that] is fixed in a casing 16 by means of securing rings." Column 3, lines 14 to 15. However, Reisinger et al. do not describe any arrangement for preventing the relative rotation of the casing 16 and the securing rings 17.

Since claims 12 and 13 depend from independent claim 1, and since Reisinger et al. simply do not cure the critical deficiencies of the combination of Werner et al. and Dierker et al., it is respectfully submitted that claims 12 and 13 are allowable for at least the same reasons that claim 1 is allowable. In re Fine, supra. Withdrawal of this rejection is therefore respectfully requested.

V. Rejection of Claim 14 Under 35 U.S.C. § 103(a)

Claim 14 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Werner et al., Dierker et al., and U.S. Patent No. 5,066,025 ("Hanrahan"). It is respectfully submitted that the combination of Werner et al., Dierker et al. and Hanrahan does not render obvious claim 14 for the following reasons.

As more fully set forth above, the combination of Werner et al. and Dierker et al. does not disclose, or even suggest, all of the limitations of claim 1. Claim 14 depends from claim 1 and therefore includes all of the limitations of claim 1. Hanrahan is not relied on to disclose or suggest, and does not disclose or suggest, those features of claim 1 not disclosed or suggested by the combination of Werner et al. and Dierker et al. For instance, Hanrahan is not relied on to disclose or suggest, and does not disclose or suggest, that the first positioning arrangement and the second positioning arrangement are configured to interact with each other in a positive-locking manner and to provide definite positioning of the bristle housing so as to prevent relative rotation and incorrect mounting of the entire bristle housing, which as set forth more fully above, is not disclosed or suggested by the combination of Werner et al. and Dierker et al. Since claim 14 depends from independent claim 1, and since Hanrahan simply does not cure the critical deficiencies of the combination of Werner et al. and Dierker et al., it is respectfully submitted that claim 14 is allowable for at least the same reasons that claim 1 is allowable. In re Fine, supra.

VI. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.



Respectfully submitted,

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